

**RECEIVED
CENTRAL FAX CENTER
OCT 15 2009**

Doc Code: A.P.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012, OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)												
		October 15, 2009												
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on /Charlena Thorpe/ Signature Charlena Thorpe</p> <p>Typed or printed name 48,035</p>														
<table border="1"> <tr> <td>Application Number</td> <td>Filed</td> </tr> <tr> <td>678-644-9922</td> <td>March 3, 2004</td> </tr> <tr> <td colspan="2">First Named Inventor</td> </tr> <tr> <td colspan="2">Michelle Grandy</td> </tr> <tr> <td>Art Unit</td> <td>Examiner</td> </tr> <tr> <td>3765</td> <td>Le, Tan</td> </tr> </table>			Application Number	Filed	678-644-9922	March 3, 2004	First Named Inventor		Michelle Grandy		Art Unit	Examiner	3765	Le, Tan
Application Number	Filed													
678-644-9922	March 3, 2004													
First Named Inventor														
Michelle Grandy														
Art Unit	Examiner													
3765	Le, Tan													

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. 48,035
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/Charlena Thorpe/

Signature

Charlena Thorpe

Typed or printed name

678-644-9922

Telephone number

October 15, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
--------------------------	--------------------------------------

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary, depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Michelle Grandy
Appln. No.: 10/792,107
Filed: March 3, 2004
Title: DECORATIVE HANGING WASTEBASKET

October 15, 2009

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ARGUMENTS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully submits the following arguments in support of Applicant's pre-appeal brief request.

35 U.S.C § 102(B) REJECTIONS GENERALLY

The Examiner has wholly failed to perform the Examiner's duty to answer all material traversed. See, e.g., MPEP § 707.07(f). In Applicant's response dated December 31, 2008, Applicant concisely pointed out the numerous claimed elements that are disclosed in the cited references. Yet, the Examiner did not respond to the vast majority of Applicant's arguments. For instance, with respect to the 102(b) rejection in view of Har, Applicant argued:

1. Har does not disclose "a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit" as recited in claim 1. See Response dated December 31, 2008 at 10-11.
2. Claim 19 recites that "the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a first direction." Claim 20, which depend from claims 19, recites that the first direction is directed toward a front elevation. Har does not teach or suggest that the alleged cover (element 32) conceals in whole the storage unit when viewed from a first direction or a direction directed toward a front elevation. See Response dated December 31, 2008 at 11-12.

Docket No. 053946/338424

3. Claim 21 recites, "the cover is sized and positioned on the holder to conceal in whole the storage unit *and holder* from being viewed in a first direction." Claim 22, which depends from claim 21, recites that the first direction is directed toward a front elevation. Har does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction or a direction directed toward a front elevation. See Response dated December 31, 2008 at 13.
4. Claim 27 recites, "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction." Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. Har does not disclose these elements. See Response dated December 31, 2008 at 13.
5. Claim 29 recites, "a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction." Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. Har does not teach or suggest that the alleged cover (element 32) includes "at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket." Also, Har does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction" or a front elevation. See Response dated December 31, 2008 at 13-14.
6. Claim 12 recites an apparatus comprising means for securing a storage unit to a surface; and means for concealing in whole or in part means for securing. The Examiner contends that the means for securing in Har are elements 50 and 52 and that the means for

Docket No. 053946/338424

concealing is element 32. However, these elements in Har are different than and are not equivalent to the corresponding structure for first means for securing and second means for concealing. See Response dated December 31, 2008 at 14.

Despite Applicant's numerous arguments, the Examiner only commented on claim 19 (completely ignoring Applicant's arguments with respect to claims 1, 12, 20, 21, 22, 27, 28, 29, and 30). See Final Office Action dated April 15, 2009 at 4-5. Furthermore, the Examiner erroneously stated that "there is nothing in the disclosure/claim to indicate which direction is the first direction." Id. However, claim 20 clearly recites, "wherein the first direction is directed toward a front elevation."

With respect to the 102(b) rejection in view of Larkin, Applicant argued:

1. Larkin does not disclose "a cover attached to the holder, wherein the cover is sized to conceal in whole or in part the storage unit" as recited in claim 1. See Response dated December 31, 2008 at 15-16.
2. Claim 19 recites that "the cover is sized and positioned on the holder to conceal in whole the storage unit from being viewed in a first direction." Claim 20, which depends from claims 19, recites that the first direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole the storage unit when viewed from a first direction or a direction directed toward a front elevation. See Response dated December 31, 2008 at 16-17.
3. Claim 21 recites, "the cover is sized and positioned on the holder to conceal in whole the storage unit and holder from being viewed in a first direction." Claim 22, which depends from claim 21, recites that the first direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) conceals in whole a storage unit and holder when viewed from a first direction or a direction directed toward a front elevation. See Response dated December 31, 2008 at

Docket No. 053946/338424

17-18.

4. Claim 27 recites, "a cover connected to the holder and structured and positioned on the holder to conceal a container held by the holder from being viewed in at least one direction." Claims 28, which depends from claim 27, recites that the at least one direction is directed toward a front elevation. Larkin does not disclose these elements. See Response dated December 31, 2008 at 18.
5. Claim 29 recites, "a cover . . . that includes at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket supported by the holder and wherein the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction." Claims 30, which depends from claim 29, recites that the at least one direction is directed toward a front elevation. Larkin does not teach or suggest that the alleged cover (element 32) includes "at least one surface with dimensions equivalent to or greater than at least one surface of a wastebasket." Also, Larkin does not teach or suggest that "the cover is connected to the third section of the holder in an orientation that hides the at least one surface of the wastebasket from being seen from at least one direction" or a front elevation. See Response dated December 31, 2008 at 18.
6. Claim 4 recites that "wherin the cover comprises a second mounting piece connected to the first mounting piece." Furthermore, with respect to claim 16, which recites, "a second mounting piece structured to attach to the cover and first mounting piece", Larkin does not disclose that element 36 is structured to attach to element 42. See Response dated December 31, 2008 at 19.
7. Claim 12 recites an apparatus comprising means for securing a storage unit to a surface; and means for concealing in whole or in part means for securing. The Examiner contends that the means for securing in Larkin are elements 60, 42, and 14 and that the means for

Docket No. 053946/338424

concealing is element 32. However, these elements in Larkin are different than and are not equivalent to the corresponding structure for first means for securing and second means for concealing. See Response dated December 31, 2008 at 19-20.

As with the Har reference, the Examiner completely ignored Applicant's arguments with respect to Larkin. Instead, the Examiner illogically argued that "Applicant's, arguments . . . with respect . . . Larkin appear to be similar to the Har's (sic) argument Therefore the examiner's response is going to be the same." See Final Office Action dated April 15, 2009 at 6. However, Har and Larkin are two entirely different references and the Examiner response for Larkin cannot "be the same" as his response to Har since the Examiner has a duty to particularly point out where in the reference an element is disclosed See 37 CFR § 1.104; MPEP § 706.

The Examiner also argues that "applicant's arguments are directed toward the intended function instead of how the claims structurally distinguish the invention from the prior art." See Final Office Action dated April 15, 2009 at 6. However, Applicant addressed this argument in Applicant's response dated December 31, 2008 at 10-11.

35 U.S.C § 112, SECOND PARAGRAPH, REJECTION

It appears that the Examiner continues to reject claim 2 under 35 U.S.C § 112, second paragraph, because "in claim 2[] . . . the surface . . . still indicates positively recited." Applicant has addressed this rejection many times in the past. See Amendment dated July 5, 2005 at 19-21; Applicant's Amended Appeal Brief dated March 9, 2007 at 8-10; Response dated December 17, 2007 at 2-6; Response dated December 31, 2008 at 6-10. Applicant respectfully submits that claim 2 satisfies 35 U.S.C. § 112, second paragraph, and that Applicant is not required to amend this claim.

[Signature on Next Page]

Docket No. 053946/338424

Respectfully submitted,

/Charlena Thorpe/
Charlena L. Thorpe, Reg. No. 48,035

THE LAW OFFICE OF CHARLENA THORPE, INC.
The Sugarloaf Center
2180 Satellite Boulevard Suite 400
Duluth, GA 30097
678-644-9922